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EXAMINER
ERB, NATHAN

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Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-6 and 8-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6 and 8-26* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2.   Applicants' response to Office action was received on June 21, 2006.

3.   Regarding applicants' arguments with respect to the Swix et al. reference, applicants first argue that Swix et al. does not disclose postponing the expiration of a time period until after a job is completed. Applicants argue that Swix et al. merely teaches disabling a VCR control of an interactive media service when the remaining time of a viewed program is the same as a remaining allowed period for viewing that program. Applicants are correct that disabling a VCR control of an interactive media service when the remaining time of a viewed program is the same as a remaining allowed period for viewing that program is disclosed by the reference. However, that does not mean that other concepts are not disclosed by the reference as well. The reference also discloses wherein, when said control section detects expiration of the trial period for a function during execution of a job thereof, then said control section postpones the expiration of the trial period for the function until the time the job of the function is actually completed (column 4, lines 29-45). If one views the time allowed for viewing a program as the time for performing the function/job of delivering the program, Swix et al. provides a "grace period" for viewing the program by providing a time window for viewing the program that is greater than the length of the program. This is the same as extending the viewing time for a program when the ending might otherwise have been cut off, which is one of the purposes of the invention of Swix et al. As a side note, the disabling of features in Swix et al. to ensure that enough time

remains in the "grace period" to reach the end of the program allows the "grace period" to be an extension of time that lasts until the program (the function/job) is completed. The fact that Swix et al. is applying its concepts to delivering a television program is irrelevant; Swix et al. is analogous art in this case because extending a period for providing a business service, delivering a television program, is in the business method arts, as is applicants' invention; in addition, Swix et al. does indeed disclose the general concept for which it was cited in the previous Office action, that of wherein, when said control section detects expiration of the trial period for a function during execution of a job thereof, then said control section postpones the expiration of the trial period for the function until the time the job of the function is actually completed.

Applicants argue that Swix et al. cannot be combined with Fenstemaker et al. because ultrasound devices do not have VCR-like controls. However, note that the disclosure of Swix et al. being used is the more general concept given above, not a specific concept regarding, for example, rewind and fast-forward buttons. Since Swix et al. is not being used for disclosure of specific controls, whether those controls could specifically result in an extension of time in an ultrasound device is not an issue, in contrast to such argument by applicants. Applicants also question what aspect of Fenstemaker et al. would correspond to the "runtime" of the program of Swix et al. To answer that question, the time that the program is actually being viewed in Swix et al. corresponds to the time that some particular temporarily-enabled feature is being utilized in Fenstemaker et al. The extended "grace period" time of Swix et al., when applied to Fenstemaker et al. would allow an extension of a trial period to occur when a temporarily-enabled feature of Fenstemaker et al. is being utilized at the time of termination of the original

trial period, such that the extension of time would allow whatever function then currently being performed by the particular feature to be completed.

Applicants also argue that Swix et al. does not teach postponing an expiration as claimed, but rather teaches forcing a "job" to finish within a given period of time. While Swix et al. can be viewed as "forcing" a job to finish within a given period of time, it does also teach postponing an expiration. If Swix et al. did not provide its "grace period" (column 4, line 40) and simply provided a window of viewing of the same length as the program watched a single time with no pausing, fast-forwarding, or rewinding, the viewing window would "expire" at the end of that program length time, as opposed to that program length time plus "grace period" time, as disclosed by Swix et al. Therefore, Swix et al. does indeed disclose postponing an expiration.

Applicants further argue that Swix et al. does not apply in this case because the grace period in Swix et al. is fixed. However, this limitation *in the wording used in applicants' claims*, does not require the grace period to be non-fixed; rather it is defined as continuing until the time the job of the function is actually completed. Swix et al. disables pause and rewind controls such that the television program will end at the same time as the grace period, therefore, Swix et al. discloses a grace period which continues until the time the job of the function is actually completed.

Applicants further argue that Swix et al. does not apply in this case because Swix et al. postpones expiration of the trial period prior to the time of expiration of the original trial period, unlike applicants' claims. According to Webster's II Dictionary, Third Edition, Office Edition, Houghton Mifflin Company, New York, 2005, p. 554, "postpone" means "To put off to a later time." Therefore, in the grace period of Swix et al., the system is in fact postponing the

expiration of the viewing time period beyond the uninterrupted, original program length at the

point when the uninterrupted, original program length would have expired, putting off that

expiration to a later time, even though the decision to do so was made at the time the total

viewing period window of Swix et al. was calculated.

Applicants argue that Swix et al. does not contain the limitation of a trial period that is set

according to a received instruction. This argument is irrelevant because this limitation was

included in the base reference of Fenstemaker et al. and was addressed in the rejection of claims

1 and 24 in the previous Office action.

Therefore, applicants' arguments with respect to the Swix et al. reference are not

persuasive.

4.   Regarding claim 5, applicants argue that there is inadequate motivation to modify

Fenstemaker et al. with Kohtani et al. because the rejection acknowledges that all of the

functions listed must be operational, so one skilled in the art would not be motivated to check

whether the functions are operational. To explain further, while Fenstemaker et al. essentially

states that all of the disabled features on the ultrasound device can be enabled, it is possible that

this may not always be a valid assumption. For example, a component of the system needed to

perform a particular feature could break. In such a case, where Fenstemaker et al. essentially

assumes that all of the disabled features are operational, one skilled in the art would still be

motivated to perform a check on which functions are actually operational, as disclosed by

Kohtani et al. Kohtani et al. provides motivation, as addressed in the previous Office action's

rejection, in that it explains that in order to use a function, it is necessary to know what functions

are operational on a device (column 1, lines 10-25). Applicants also seemingly argue that

Kohtani et al. is not similar enough to Fenstemaker et al. to be applicable to Fenstemaker et al. While Kohtani et al. and Fenstemaker et al. are different references, the concepts for which Kohtani et al. is cited are broad enough to apply to Fenstemaker et al.

Therefore, applicants' arguments with respect to claim 5 are not persuasive.

5.   Regarding applicants' arguments with respect to claims 17-21, applicants argue that Shimizu et al. is non-analogous art because it is not in the same field as Fenstemaker et al. The analogous art question, however, does not hinge on whether Shimizu et al. and Fenstemaker et al. are in the same art; it hinges on whether Shimizu et al. is analogous art to the applicants' invention and whether Fenstemaker et al. is analogous art to the applicants' invention. Shimizu et al. is analogous art to the applicants' invention because both are in the copying machine art. Fenstemaker et al. is analogous art to the applicants' invention because both are in the business methods art, specifically that of supplying trial features. Thus, applicants' analogous art argument here is not persuasive.

Applicants further argue that the motivation suggested in the Office action appears to simply provide an ultrasound device with the features of an image recording apparatus and that there is no suggestion that one skilled in the art of ultrasound devices would seek to provide an ultrasound device with a particular copier machine function. The question is not what one skilled in the art of ultrasound devices would do, but what one skilled in the art of applicants' invention (business methods, specifically providing trials, and copy machines) would do. Having access to the trial-providing method of Fenstemaker, it would indeed be obvious to modify Fenstemaker such that its trial-providing method is applied to other types of machines,

such as the copy machine of Shimizu et al., from the other field of knowledge of this case's

hypothetical person of ordinary skill in the art.

Therefore, applicants' arguments with respect to claims 17-21 are not persuasive.

6.   In light of applicants' amendments to the claims, the claim rejections below have been

correspondingly modified.

Claim Objections

7.   In response to applicants' amendment of the claims received on June 21, 2006, the

objections to claims 7 and 21 from the previous Office action have been withdrawn.

Claim Rejections - 35 USC § 112

8.   In response to applicants' amendment of the claims received on June 21, 2006, all of the

rejections under 35 U.S.C. 112, second paragraph, have been withdrawn.

Claim Rejections - 35 USC § 101

9.   In response to applicants' amendment of the claims received on June 21, 2006, the

rejection of claim 24 under 35 U.S.C. 101 from the previous Office action has been withdrawn.

Claim Rejections - 35 USC § 103

10.   Claims 1-3, 6, 8-9, 11, 13-14, and 24-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Fenstemaker et al., U.S. Patent No. 6,490,684 B1, in view of Swix et al., U.S.

Patent No. 6,609,253 B1.

As per **Claims 1 and 24**, Fenstemaker et al. discloses:

- a trial management system (column 1, lines 38-50);

- a storage section storing one or more functions to be a target of trial (column 1, lines 38-50; column 2, lines 35-38);

- a trial instruction giving section for receiving a user's instruction on a trial period for said function (column 1, lines 38-50);

- a specifying section for specifying a function, a trial of which is started, according to an instruction received by said trial instruction giving section (column 1, lines 38-50);

- a control section for setting a trial period for the function specified by said specifying section in accordance with the instruction received by said trial instruction giving section (column 1, lines 38-50; column 4, lines 16-30; column 5, lines 1-13);

- a program for a computer tangibly embodied on a computer-readable medium (column 5, lines 41-67).

Fenstemaker et al. fails to disclose wherein, when said control section detects expiration of the trial period for a function during execution of a job thereof, then said control section postpones the expiration of the trial period for the function until the time the job of the function is actually completed. Swix et al. discloses wherein, when said control section detects expiration of the trial period for a function during execution of a job thereof, then said control section postpones the expiration of the trial period for the function until the time the job of the function is actually completed (column 4, lines 29-45; the reference is analogous art because it is in the same field of endeavor as applicants' invention, that is, the business method arts; the time for watching the program is the trial period in this case; the function in this case is delivering the program; the job in this case is a single program order; the grace period in the reference is effectively an extension of time to finish watching the program). It would have been obvious to

one of ordinary skill in the art at the time of applicants' invention to modify the invention of

Fenstemaker et al. such that when said control section detects expiration of the trial period for a

function during execution of a job thereof, then said control section postpones the expiration of

the trial period for the function until the time the job of the function is actually completed, as

disclosed by Swix et al. Swix et al. provides motivation in that a grace period to finish a job

avoids the job being cut off in the middle (column 2, lines 28-50; column 4, lines 37-42).

As per **Claim 2**, Fenstemaker et al. further discloses: wherein said trial instruction giving

section receives the user's instruction in the form of input of a trial key associated with each

function (column 1, lines 38-50).

As per **Claim 3**, Fenstemaker et al. further discloses: wherein said trial key includes data

of said function itself and trial-use limitations imposed thereon (column 4, line 61, through

column 5, line 13); when said trial key is inputted to said trial instruction giving section, said

control section sets a trial period for a function specified by the trial key received by said trial

instruction giving section according to the trial-use limitations indicated by the trial key received

by said trial instruction giving section (column 1, lines 38-50; column 4, line 61, through column

5, line 13).

As per **Claim 6**, Fenstemaker et al. further discloses: wherein said control section

changes a trial period for said function (column 4, lines 31-44).

As per **Claim 8**, Fenstemaker et al. further discloses: wherein said trial instruction giving

section receives the user's instruction in the form of a specified key associated with a trial period

of each function (column 1, lines 38-50; column 4, lines 31-44; p. 14 of applicants' specification

gives an example for a "specified key" wherein the key changes a trial period); said control

section sets the trial period of said function according to data of the trial period indicated by the

specified key received by said trial instruction giving section (column 1, lines 38-50; column 4,

lines 31-44; p. 14 of applicants' specification gives an example for a "specified key" wherein the

key changes a trial period).

As per **Claim 9**, Fenstemaker et al. further discloses: wherein said control section judges

whether or not the specified key received by said trial instruction giving section indicates data

which extends a trial period, and extends the trial period for the function specified by said trial

instruction giving section when said specified key indicates the data which extends the trial

period (column 1, lines 38-50; column 4, lines 31-44; p. 14 of applicants' specification gives an

example for a "specified key" wherein the key changes a trial period).

As per **Claim 11**, Fenstemaker et al. further discloses: wherein said control section

judges whether or not the specified key is an authorized key which gives an instruction to

terminate the trial period so as to proceed to a state of authorized use, and when the specified key

received by said trial instruction giving section is the authorized key, said control section

terminates the trial period for the function specified by said trial instruction giving section and

proceeds to the state of authorized use (column 1, lines 38-50; column 4, lines 31-44).

As per **Claim 13**, Fenstemaker et al. further discloses: wherein said trial instruction

giving section is an operation panel which is provided with a key group for receiving the user's

instruction and a display section for displaying guidance information including a process status

with respect to the user (column 2, line 55, through column 3, line 26).

As per **Claim 14**, Fenstemaker et al. further discloses: wherein said storage section

stores a plurality of functions to be the target of trial (column 1, lines 38-50; column 2, lines 35-

38); said display section displays a list of some of said plurality of functions which are confirmed

as available (column 2, line 55, through column 3, line 26).

As per **Claim 25**, Fenstemaker et al. discloses:

- a trial management system (column 1, lines 38-50);

- a storage section storing one or more functions to be a target of trial (column 1, lines

38-50; column 2, lines 35-38);

- a trial instruction giving section for receiving a user's instruction on a trial period for

said function (column 1, lines 38-50);

- a specifying section for specifying a function, a trial of which is started, according to an

instruction received by said trial instruction giving section (column 1, lines 38-50);

- a control section for setting a trial period for the function specified by said specifying

section in accordance with the instruction received by said trial instruction giving section

(column 1, lines 38-50; column 4, lines 16-30; column 5, lines 1-13);

- a program for a computer (column 5, lines 41-67);

- a computer-readable recording medium (column 5, lines 60-63).

Fenstemaker et al. fails to disclose the function-controlling program being recorded on a computer-readable recording medium. However, that element/limitation was well-known in the art at the time of applicants' invention (computer programs are commonly recorded on computer-readable recording media). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. such that the function-controlling program is recorded on a computer-readable recording medium, as was well-known in the art at the time of applicants' invention. Motivation is provided in that it was well-known to a person of ordinary skill in the art at the time of applicants' invention that computer-readable recording media is a typical way to record computer programs.

Fenstemaker et al. fails to disclose wherein, when said control section detects expiration of the trial period for a function during execution of a job thereof, then said control section postpones the expiration of the trial period for the function until the time the job of the function is actually completed. Swix et al. discloses wherein, when said control section detects expiration of the trial period for a function during execution of a job thereof, then said control section postpones the expiration of the trial period for the function until the time the job of the function is actually completed (column 4, lines 29-45; the reference is analogous art because it is in the same field of endeavor as applicants' invention, that is, the business method arts; the time for watching the program is the trial period in this case; the function in this case is delivering the program; the job in this case is a single program order; the grace period in the reference is effectively an extension of time to finish watching the program). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of

Fenstemaker et al. such that when said control section detects expiration of the trial period for a

function during execution of a job thereof, then said control section postpones the expiration of

the trial period for the function until the time the job of the function is actually completed, as

disclosed by Swix et al. Swix et al. provides motivation in that a grace period to finish a job

avoids the job being cut off in the middle (column 2, lines 28-50; column 4, lines 37-42).

      As per **Claim 26**, Fenstemaker et al. discloses:

- a trial management system (column 1, lines 38-50);

      - a storage section storing one or more functions that are to be trial targets (column 1,

lines 38-50; column 2, lines 35-38);

      - a user input section supplied with a user's instruction on a trial for at least one of the

functions (column 1, lines 38-50);

      - a processing section for specifying the at least one function, a trial of which is started,

according to the instruction supplied to the user input section and for setting a trial period for the

trial of the specified function in accordance with the instruction supplied to the user input section

(column 1, lines 38-50; column 4, lines 16-30; column 5, lines 1-13).

      Fenstemaker et al. fails to disclose wherein, when the processing section detects

expiration of the trial period for the function during execution of a job thereof, then the

processing section postpones the expiration of the trial period for the function until the time the

job of the function is actually completed. Swix et al. discloses wherein, when the processing

section detects expiration of the trial period for the function during execution of a job thereof,

then the processing section postpones the expiration of the trial period for the function until the

time the job of the function is actually completed (column 4, lines 29-45; the reference is

analogous art because it is in the same field of endeavor as applicants' invention, that is, the

business method arts; the time for watching the program is the trial period in this case; the

function in this case is delivering the program; the job in this case is a single program order; the

grace period in the reference is effectively an extension of time to finish watching the program).

It would have been obvious to one of ordinary skill in the art at the time of applicants' invention

to modify the invention of Fenstemaker et al. such that when the processing section detects

expiration of the trial period for the function during execution of a job thereof, then the

processing section postpones the expiration of the trial period for the function until the time the

job of the function is actually completed, as disclosed by Swix et al. Swix et al. provides

motivation in that a grace period to finish a job avoids the job being cut off in the middle

(column 2, lines 28-50; column 4, lines 37-42).

11.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et al.

in view of Swix et al. in further view of Cooper et al., U.S. Patent No. 6,654,888 B1.

Fenstemaker et al. further discloses: a trial key in the form of an electronic key which is a code

to release a program subject to access-protect from the access-protect (column 1, lines 38-50;

column 2, line 55, through column 3, line 51).   Fenstemaker et al. and Swix et al. fail to

disclose wherein said trial key includes a trial key in the form of a start trial button. Cooper et al.

discloses wherein said trial key includes a trial key in the form of a start trial button (column 8,

lines 18-20; the icon acts as a start trial button). It would have been obvious to one of ordinary

skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as

modified in the rejection for claim 2 such that said trial key includes a trial key in the form of a

start trial button, as disclosed by Cooper et al. Cooper et al. provides motivation in that the start

trial button allows a trial to be started and allowing trial use may increase sales (column 8, lines

18-20, column 1, lines 22-30).

12.   Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fenstemaker et al. in view of Swix et al. in further view of Kohtani et al., U.S. Patent No.

6,236,464 B1.

        As per **Claim 5**, Fenstemaker et al. further discloses: wherein said control section sets

only those functions which are operational to be available in a trial mode (column 1, lines 38-50;

column 2, line 55, through column 3, line 26; the reference mentions the ability to make the

disabled functions in the list enabled; therefore, all of the functions listed must be operational).

Fenstemaker et al. and Swix et al. fail to disclose wherein said control section judges whether or

not said function is operational. Kohtani et al. discloses wherein said control section judges

whether or not said function is operational (column 1, line 45, through column 2, line 22; system

checks what functions are operational). It would have been obvious to one of ordinary skill in

the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as

modified in the rejection for claims 1 and 24 such that said control section judges whether or not

said function is operational, as disclosed by Kohtani et al. Kohtani et al. provides motivation in

that it explains that in order to use a function, it is necessary to know what functions are

operational on a device (column 1, lines 10-25).

As per **Claim 12**, Fenstemaker et al. and Swix et al. fail to disclose wherein said control section judges whether or not an environment which is essential to carrying out the function is completely available, and when the environment essential to carrying out the function is not completely available, said control section terminates the use of the function. Kohtani et al. discloses wherein said control section judges whether or not an environment which is essential to carrying out the function is completely available, and when the environment essential to carrying out the function is not completely available, said control section terminates the use of the function (column 9, lines 9-17). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claim 8 such that said control section judges whether or not an environment which is essential to carrying out the function is completely available, and when the environment essential to carrying out the function is not completely available, said control section terminates the use of the function, as disclosed by Kohtani et al. Motivation is provided in that it was well-known to a person of ordinary skill in the art at the time of applicants' invention that there is no value in trying to use a function which cannot be performed.

13.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et al. in view of Swix et al. in further view of Kohut, U.S. Patent No. 6,246,769 B1. Fenstemaker et al. and Swix et al. fail to disclose wherein said control section judges whether or not the key indicates correct data, and when an incorrect key is inputted a predetermined number of times, said control section terminates a function. Kohut discloses wherein said control section judges whether or not the key indicates correct data, and when an incorrect key is inputted a predetermined number of times, said control section terminates a function (column 14, lines 26-

31; claim 1; card can become useless after a predetermined number of incorrect code entries). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claim 8 such that said control section judges whether or not the key indicates correct data, and when an incorrect key is inputted a predetermined number of times, said control section terminates a function, as disclosed by Kohut. Kohut inherently provides motivation in that such a feature prevents an unauthorized person from breaking a code through several repeated trial-and-error guesses (column 14, lines 26-31; claim 1).

14.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et al. in view of Swix et al. in further view of Lieberman, Brett, "Juno to Provide New Web // Internet Access to Be Combined With Free E-mail," The Patriot-News, Final Edition, Harrisburg, PA, July 28, 1998, p. D.02. Fenstemaker et al. and Swix et al. fail to disclose listing the length of a trial period. Lieberman discloses listing the length of a trial period (section A). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claim 14 such that it lists the length of a trial period, as disclosed by Lieberman. Lieberman inherently provides motivation in that the purpose of listing the length of a trial period is obviously to communicate the length of that trial period (section A).

15.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et al. in view of Swix et al. in further view of Ochiai, U.S. Patent No. 6,195,171 B1, in further view of Shimizu et al., U.S. Patent No. 5,109,434. Fenstemaker et al. and Swix et al. fail to disclose a communications board. Ochiai discloses a communications board (column 7, lines 35-50). It

would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claims 1 and 24 such that it includes a communications board, as disclosed by Ochiai. Ochiai provides motivation in that a communications board can allow a device to communicate with other devices (column 7, lines 35-50). Fenstemaker et al., Swix et al., and Ochiai fail to disclose sending inputted image information to an external device which is a transmission destination. Shimizu et al. discloses sending inputted image information to an external device which is a transmission destination (column 1, lines 51-57). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claims 1 and 24 and as modified above in this rejection such that it sends inputted image information to an external device which is a transmission destination, as disclosed by Shimizu et al. Motivation is provided in that it was well-known to a person of ordinary skill in the art at the time of applicants' invention that transmitting information between devices allows more than one device to access the information.

16.   Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et al. in view of Swix et al. in further view of Shimizu et al.

As per **Claim 17**, Fenstemaker et al. and Swix et al. fail to disclose a scanner for scanning a desired document image as image information. Shimizu et al. discloses a scanner for scanning a desired document image as image information (column 3, lines 29-36). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claims 1 and 24 such that it

includes a scanner for scanning a desired document image as image information, as disclosed by

Shimizu et al. Shimizu et al. provides motivation in that it states that a reader unit can be used to

read an image (column 3, lines 29-36).

As per **Claim 18**, Fenstemaker et al. and Swix et al. fail to disclose an image processing

unit for performing predetermined image processing with respect to inputted image information.

Shimizu et al. discloses an image processing unit for performing predetermined image

processing with respect to inputted image information (column 39, line 61, through column 40,

line 10). It would have been obvious to one of ordinary skill in the art at the time of applicants'

invention to modify the invention of Fenstemaker et al. as modified in the rejection for claims 1

and 24 such that it includes an image processing unit for performing predetermined image

processing with respect to inputted image information, as disclosed by Shimizu et al. Shimizu et

al. provides motivation in that it states that the image processing unit can be used to control

image processing and store processed images (column 39, line 62-64).

As per **Claim 19**, Fenstemaker et al. and Swix et al. fail to disclose a storage device for

temporarily storing image information. Shimizu et al. discloses a storage device for temporarily

storing image information (column 40, lines 11-23). It would have been obvious to one of

ordinary skill in the art at the time of applicants' invention to modify the invention of

Fenstemaker et al. as modified in the rejections for claims 1 and 24 such that it includes a storage

device for temporarily storing image information, as disclosed by Shimizu et al. Motivation is

provided in that it was well-known to a person of ordinary skill in the art at the time of

applicants' invention that it is useful to be able to store information temporarily so that it may be used later.

As per **Claim 20**, Fenstemaker et al. and Swix et al. fail to disclose a printer for printing out inputted image information. Shimizu et al. discloses a printer for printing out inputted image information (column 3, lines 37-43). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejections for claims 1 and 24 such that it includes a printer for printing out inputted image information, as disclosed by Shimizu et al. Motivation is provided in that it was well-known to a person of ordinary skill in the art at the time of applicants' invention that it is sometimes useful to be able to print out image information.

As per **Claim 21**, Fenstemaker et al. and Swix et al. fail to disclose a network scanner function, whereby image data scanned by a device is transferred to another. Shimizu et al. discloses a network scanner function, whereby image data scanned by a device is transferred to another (column 39, line 61, through column 40, line 10). It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as modified in the rejection for claims 1 and 24 such that it includes a network scanner function, whereby image data scanned by a device is transferred to another, as disclosed by Shimizu et al. Motivation is provided in that it was well-known to a person of ordinary skill in the art at the time of applicants' invention that transmitting information between devices allows more than one device to access the information.

17.   Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et

al. in view of Swix et al. in further view of Kelly, U.S. Patent No. 6,442,595 B1. Fenstemaker et

al. and Swix et al. fail to disclose an e-mail function, whereby scanned image data is transmitted

in the form of an attachment file of an e-mail. Kelly discloses an e-mail function, whereby

scanned image data is transmitted in the form of an attachment file of an e-mail (column 2, line

43, through column 3, line 7; claims 1 and 7). It would have been obvious to one of ordinary

skill in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as

modified in the rejection for claims 1 and 24 such that it includes an e-mail function, whereby

scanned image data is transmitted in the form of an attachment file of an e-mail, as disclosed by

Kelly. Motivation is provided in that it was well-known to a person of ordinary skill in the art at

the time of applicants' invention that it is sometimes useful to be able to send scanned image data

to an e-mail account.

18.   Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fenstemaker et

al. in view of Swix et al. in further view of Nakajima et al., U.S. Patent No. 5,523,859.

Fenstemaker et al. and Swix et al. fail to disclose a security function, whereby image data once

printed out is erased. Nakajima et al. discloses a security function, whereby image data once

printed out is erased (column 1, lines 51-63). It would have been obvious to one of ordinary skill

in the art at the time of applicants' invention to modify the invention of Fenstemaker et al. as

modified in the rejection for claims 1 and 24 such that it includes a security function, whereby

image data once printed out is erased, as disclosed by Nakajima et al. Nakajima et al. provides

motivation in that it is desirable to be able to erase confidential information from a device's

memory after copying the information (column 1, lines 51-53).

Conclusion

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

20.   **Examiner's Note:** Examiner has cited particular portions of the references as applied to

the claims above for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested that

the applicant, in preparing the responses, fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the context of the passage as taught by

the prior art or disclosed by the examiner.

21.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The

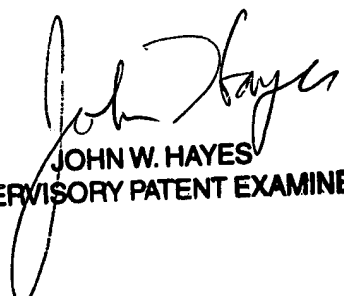examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nathan Erb
Examiner
Art Unit 3639

nhe

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER